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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,044	06/27/2000	David Black	E0295/7117(MBL)	4788

7590 08/25/2005

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Federal Reserve Plaza
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Boston, MA 02210-2211

EXAMINER

ANDERSON, MATTHEW D

ART UNIT	PAPER NUMBER
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2186

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/605,044

Applicant(s)

BLACK, DAVID

Examiner

Matthew D. Anderson

Art Unit

2186

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-27 and 37-39.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: (see attached...).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

N

Response to Arguments

1. Applicant's arguments filed 8/12/05 have been fully considered but they are not persuasive.
2. Fisher discloses in figure 5 and 6, and also column 4, lines 60+, of numerous databases maintaining identifying information for the storage volumes of its system. The Examiner is interpreting the entirety of the information from these databases as the claimed identifying information. A portion of the information shown in figure 5 identifies the mount or non mount status of the volumes. The Examiner is interpreting this mount/non-mount status of the volumes to detail whether the volume is in use or not in use. The database information disclosed in column 5, lines 1-7, identifies the owner (user) of the volume.
3. Although the claims recite multiple users of each volume, there is no explicit temporal limitation therein. In other words, is it referring to a.) multiple, single users over a period of time; or b.) to multiple users at one time. When Applicant makes the argument that Fisher only discloses maintaining identifying information for a single owner (not multiple owners), then the Examiner interprets that argument to mean that the claims are intended to be for multiple users at one time. Hence the additional references applied in the separate 103 rejections. It is true that Fisher does not disclose multiple owners at one time and does not explicitly disclose changing from one owner to another (though it is easy enough to consider that possible, or an obvious variation, over a long period of time). Therefore, if Fisher is lacking in that it does not disclose multiple owners at one time, then the previous Office Action has shown by the additional references in the 103 rejections that such would be obvious.

4. As discussed above, if it is indeed the intent of the claims for each volume to have multiple users at one time, then there does not appear to support for such in the disclosure. The cited portions of page 35 though are not sufficient to support the claim limitations in a full, clear, and concise manner as set forth in USC 112.

That a person skilled in the art might realize from reading the disclosure that such a step is possible is not a sufficient indication to that person that the step is part of appellants' invention. Such an indication is the least that is required for a description of the invention under the first paragraph of §112. See *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973). Claims added by amendment and drawn to an invention not so described in the specification are drawn to "new matter" and prohibited by §132. (See also for quote: *In re Barker and Pehl*, 194 USPQ 470 (CCPA 1977).) While there is no in haec verba requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. The trouble is that there is no such disclosure, easy though it is to imagine it. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000). The Examiner does not question whether the claim language is inconsistent with, or contradictory to, the teachings of the specification. But, the Examiner maintains that the specification does not clearly and concisely disclose to the skilled artisan that the inventors considered this particular feature to be part of their originally filed invention. There is therefore no force to the applicants' arguments that the written description requirement was satisfied because the disclosure revealed a broad invention from which the later-filed claims carved out a patentable portion.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Anderson whose telephone number is (571) 272-4177. The examiner can normally be reached on Monday-Friday, 2nd Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew M. Kim can be reached on (571) 272-4182. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew D. Anderson
Primary Examiner
Art Unit 2186